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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/770,943

01/25/2001

Eyal Raz

UCAL173CON

8209

24353

7590

02/23/2005

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EXAMINER

DUFFY, PATRICIA ANN

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/770,943

Applicant(s)

RAZ ET AL.

Examiner

Patricia A. Duffy

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-37 is/are pending in the application.  
4a) Of the above claim(s) 1-12 and 15-31 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 32-37 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 1-12, 15-37 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### RESPONSE TO AMENDMENT

The amendment filed 9-20-04 has been entered into the record. Claim 13 has been cancelled. New claims 30-37 have been added. Claims 1-12 and 15-37 are pending. Claims 32-37 are under examination.

The text of Title 35 of the U.S. Code not reiterated herein can be found in the previous office action.

### *Election/Restrictions*

Newly submitted claims 30 and 31 and amended claims 1-5, 11 and 12 are directed to a species invention that are independent or distinct from the invention originally claimed for the following reasons: the claims present a new limitation of "wherein the nucleic acid comprises a phosphate backbone modification" and further limit the phosphate backbone modification to phosphorothioate or phosphorodithioate (claims 30 and 31), not previously claimed. These claims are drawn to structurally distinct species of nucleotide sequences because they are drawn to artificial linkages in the nucleotide sequence phosphate backbone having particular synthetic structures. A search and examination for the natural linkage does not provide a search and examination on the artificial linkage as now claimed. As such, the claims are drawn to a modified species of backbone linkages that are structurally distinct species of invention.

Since applicant has received an action on the merits for the originally presented species of invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-5, 11, 12 and 30-31 are withdrawn from consideration as being directed to non-elected invention. See 37 CFR 1.142(b) and MPEP S 821.03.

This application also contains claims 6-9, 14, 22, 23 and 25-29 are drawn to an invention nonelected with traverse in the response filed 12-8-03. A complete reply to the

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final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### *Rejections Withdrawn*

Any rejection not maintained herein is withdrawn based upon the amendment to the claims to recite a distinct species of invention that has been held as drawn to a non-elected species of invention.

#### *New Rejections Based on Amendment*

##### *Double Patenting*

Claims 32-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 7, 14, 30 and 34 of U.S. Patent No. 6,225,292. Although the conflicting composition claims are not identical, they are not patentably distinct from each other because the species of comprising the hexameric CpG motif of claim 1, AAGGTT nucleotide sequence and less than about 45 nucleotides in length anticipates the instant genus claims with the range of 6-45 nucleotides in length. That is the species AAGGTT anticipates the claims and the range of 6-45 is rendered obvious by claims 1 and claim 7 that define the lower limit as 6 and the upper limit of "less than about 45". Further, it would have been obvious to link the nucleic acid as claimed to a peptide in view of claim 30 that provides for linking the nucleic acid to a peptide.

##### *Status of Claims*

Claims 1-12, 14-31 are withdrawn from consideration. Claims 32-37 are rejected.

##### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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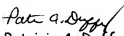
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy whose telephone number is 571-272-0855. The examiner can generally be reached on M-Th 6:30 am - 6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

  
Patricia A. Duffy

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Primary Examiner

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